

However, it is respectfully submitted that the above characterization somewhat overstates the reference value of KOBAYASHI relative to the present claims. In particular, while KOBAYASHI et al. mentions diphenylamine as a "typical example" of the formula (1) compounds in the passage at column 2, lines 56-61, the ensuing passage at column 2, lines 61-64 indicates that diphenylamine is not among the preferred monomers of KOBAYASHI, with polyaniline being especially preferred.

Perhaps more importantly, KOBAYASHI teaches that the monomers of formulae (1) and (2) may be used to form homopolymers or copolymers. As none of the examples of KOBAYASHI involve a diphenylamine polymer, the reference teaches nothing that would have directed the skilled artisan toward a homopolymer of diphenylamine rather than a copolymer of diphenylamine and some other co-monomer. Therefore, the supposition on which the obviousness rejection is based would require the further condition that the skilled artisan not only would have selected diphenylamine from among the expressly less-preferred monomers of formula (1), but also would have formed a homopolymer with that less-preferred species, rather than a copolymer. The distinction is hardly trivial; for example, a company website listing certain commercially available conductive polymers shows only one item including diphenylamine, in the form of a copolymer. See <http://www.adsdyes.com/ConductingPolymers.htm>.

As the Official Action does not fully address or justify the selections among the various possibilities of the KOBAYASHI disclosure that would be necessary to arrive at a conductive polymer as claimed, it does not make out a proper *prima facie* case of obviousness relative to any of claims 1-6 and 11-14.

Furthermore, assuming *arguendo* that the disclosure of KOBAYASHI would render *prima facie* obvious present claims 1-6 and 11-14 if read in isolation, the present specification sets forth comparative data effective to rebut any such *prima facie* case of obviousness.

In particular, Examples 1-3 compare conductive polymers according to the invention with identically prepared Comparative Examples 1-3, respectively, the Comparative Examples differing only in that they contain polyaniline rather than polybiphenylaniline. Among the polymers actually exemplified by KOBAYASHI, none appears to be structurally more similar to the claimed polymers than polyaniline itself, such that the data in the present specification makes a probative showing relative to the reference.

As the Examiner is aware, comparative data in the specification is entitled to the same weight as data set forth in a Rule 132 declaration. See, for example, *In re Wright*, 848 F.2d 1216, 6 USPQ2d 1959 (Fed. Cir. 1988):

Factors including unexpected results, new features, solution of a different problem, novel properties, are all considerations in the determination of obviousness

in terms of 35 U.S.C. § 103. When such factors are described in the specification they are weighed in determining, in the first instance, whether the prior art presents a prima facie case of obviousness.

Thus, the comparative data in the specification, illustrated graphically in present Figs. 2-5, further establishes the patentability of the present claims relative to the disclosure of KOBAYASHI.

It is accordingly believed from the above discussion that claims 1-6 and 11-14 are allowable over the prior art of record. As claim 1 remains generic to the non-elected species of claims 7-10 and 15-18, it is further believed that this application is now in condition for allowance, with all of claims 1-18. Allowance and passage to issue on that basis are accordingly respectfully requested.

Respectfully submitted,

YOUNG & THOMPSON

Thomas W. Perkins
THOMAS W. PERKINS
33027

By *JAV*

Andrew J. Patch
Attorney for Applicants
Registration No. 32,925
745 South 23rd Street
Arlington, VA 22202
Telephone: 521-2297

January 3, 2002